

Application Number: 09/855,272

Docket Number: 10010535-1

REMARKS

Upon entry of this Response, claims 1-27 remain pending in the present application. No amendments are presented herein, where the claims are listed in their current state for the sake of convenience. Applicant respectfully requests reconsideration of the pending claims in view of the following remarks.

In item 3 of the Office Action, claims 1-27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,163,779 issued to Mantha *et al.* (hereafter "*Mantha*"), U.S. Patent Application Publication No. US 2003/0115546 A1 filed by Dubey *et al.* (hereafter "*Dubey*"), and further in view of U.S. Patent No. 6,813,711 issued to Dimenstein (hereafter "*Dimenstein*"). A *prima facie* case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, *In re Rijckaert*, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicant asserts that the rejection of claims 1-27 is improper. Accordingly, Applicant requests that the rejection of these claims be withdrawn.

To begin, claim 1 provides as follows:

1. A method for writing a hypermedia file to a multimedia storage device, comprising:
 - depicting a content of the hypermedia file in a graphical user interface using an application in a computer system;
 - associating a write actuator with the content of the hypermedia file depicted in the graphical user interface;
 - determining if any of the content of the hypermedia file is restricted from being stored in the multimedia storage device upon manipulation of the write actuator;
 - packaging at least a non-restricted portion of the hypermedia file for storage in the multimedia storage device; and
 - writing the at least the non-restricted portion of hypermedia file to the multimedia storage device.

With respect to claims 1, 9, 17, and 22, the Office Action states:

"However, Mantha and Dubey do not explicitly disclose determining if any of the content of the hypermedia file is restricted from being stored in the multimedia storage device upon manipulation of the write actuator. Dimenstein discloses user clicks on a mouse selector button on the file that the user wishes to download, and Software Program retrieves the IP address of the server that stores the file that has been selected by the user to be downloaded, Software Program then sends a query to central server to determine whether the IP address for the server is listed on the Approved Web Site Database, and if it is not listed among the web sites on the Approved Web Site Database, the

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Software Program provides the user with an option that may be displayed on user's screen to either download the selected file in an unencrypted format (non-restricted file) (col. 4, line 44 - col. 5, line 55). Since *Dimenstein* discloses downloading files via Internet, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Dimenstein* and *Mantha-Dubey* to include determining if any of the content of the hypermedia file is restricted from being stored in the multimedia storage device upon manipulation of the write actuator to prevent downloading files that are available illegally." (Office Action, pages 3-4).

Applicant respectfully disagrees. First, *Dimenstein* merely shows determining whether a given server is listed on an "Approved Web Site Database". In this respect, an "Software Program" provides a user with an option to download a selected file in a manner that allows for encryption by special coding (if the web site is listed in the approved database) for use with a playback device or other device, or the user may download the file in a manner in which encryption is not performed (when the web site is not listed).

While *Dimenstein* may show or suggest the concept of a server being placed on an "Approved Web Site Database", *Dimenstein* fails to show, or suggest determining if any of the actual content of the file is restricted from being stored on a multimedia device upon manipulation of a write actuator as claimed. Also, *Dimenstein* fails to show or suggest packaging at least a non-restricted portion of the file for storage, and writing the at least non-restricted portion of the file to the multimedia storage device. In fact, ultimately *Dimenstein* provides no barrier to downloading the file itself. This is acknowledged by the Office Action which states that the "Software Program" provides the user with an option that may be displayed on user's screen to either download the selected file in an unencrypted format.

The Office Action then makes the broad assertion that since *Dimenstein* discloses

"...downloading files via Internet, it would have been obvious to one of ordinary skill at the time the invention was made to combine the teachings of *Dimenstein* and *Mantha-Dubey* to include determining if any of the content of the hypermedia files restricted from being stored in the multimedia storage device upon manipulation of the write actuator to prevent downloading files that are available illegally."

The mere fact that *Dimenstein* discloses downloading files via the Internet does not show or suggest the concept of determining if any of the content of the

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hypermedia files restricted from being stored in the multimedia device upon manipulation of a write actuator as claimed. Thus, Applicant asserts that the cited elements above in claim 1 are simply not shown or suggested in any of the references. Given that the cited references fail to show or suggest all of the elements of the claimed invention, it necessarily follows that the instant rejection is based upon the Examiner's personal knowledge.

When a rejection in an application is based on facts within the personal knowledge of an Examiner, it should be specific as possible. When called for by the Applicant, the Examiner must support the assertion with an Affidavit, which is subject to contradiction or explanation by the Affidavit of the Applicant or other persons. See 37 CFR 1.104(d)(2). Accordingly, Applicant hereby expressly calls for the Examiner to supply an Affidavit attesting to the existence of the elements not shown or suggested by the references, or that a proper reference be cited as showing such elements. Otherwise, the rejection of claim 1 must be withdrawn. In addition, Applicant requests that the rejection of claims 9, 17, and 22, be withdrawn to the extent that such claims incorporate subject matter similar in scope of that of claim 1. Finally, Applicant requests that the rejection of claims 2-8, 10-16, 18-21, and 23-27 be withdrawn as depending from claims 1, 9, 17, or 22, respectively.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,



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